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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,189	06/06/2001	Catia Bastioli	13929/122995	6578

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EXAMINER

RAJGURU, UMAKANT K

ART UNIT	PAPER NUMBER
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1711

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DATE MAILED: 03/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-2

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-17 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-17 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
    - ☐ received.
    - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

1. Claims 1-17 are ~~under~~<sup>under</sup> examination.

- CFR 1.72(b).** An abstract on a separate sheet is required.

- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 16 <sup>to</sup> rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. ~~to 512~~ <sup>me</sup>  
E62

Claim 16 provides for the use of an additive, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

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Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite in reciting the expression, "numeric mean dimension" on line 11.

Meaning of this expression is not clear.

Claim 1 is also vague in failing to specifics which "values" are envisioned.

Claim 2 is indefinite since it is not known if only "cellulose" or a "cellulose ester" is envisioned.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bastioli et al (EP 0722980) in view of Mayer et al (Biodegradable blends...., J. Macro Sci, vol a32, no. 4, 1995, pp 775-785) and JP 07102114..

(All references have been cited on IPER and PTO-1449).

Bastioli discloses biodegradable compositions comprising (a) starch, (b) a cellulose ester or ether, (c) a plasticizer for starchy phase, cellulose and derivatives and (d) and compatibilizer agent (abstract). Starch and cellulose are present in a range from 1:90 to 90:1 by wt (p. 10, lines 31-33). Plasticizer is present from 5-40% by wt (p. 10, line 55 to p. 11, line 1). Compatibilizing agents described on page 2, lines 31-50 read on those encompasses by instant claims 9-11.

Various articles can be moulded (p.2, lines 20-22).

Bastioli does not mention an additive (of instant claim 1).

Mayer discloses biodegradable blends of cellulose acetate and starch. Degree of substitution *WKS* of cellulose acetate should be 2.5 or less (~~pg.~~ 776, 3rd paragraph). In expensive fillers are added to the blends.

JP'07102114 also discloses a biodegradable composition containing cellulose ester, starch and plasticizer together with an additive like talc, calcium carbonate, magnesium carbonate etc.

Therefore it would have been obvious to add to the composition of Bastioli, carbonates and hydroxides of calcium and magnesium in order to reduce the cost of production, without affecting quality and performance. It would also be obvious to use cellulose ester i.e. polysaccha

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ride of degree of substitution of not more than 2.5 in order to maintain good biodegradability of the composition.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U.K. Rajguru whose telephone number is (703) 308-3224. The examiner can normally be reached on Monday-Friday from 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck, can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310/9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Examiner Rajguru/ng

March 19, 2002

